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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/629,846	07/30/2003	James Thomas Edward McDonnell	1509-431	6136

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EXAMINER

BALAOING, ARIEL A

ART UNIT PAPER NUMBER

2683

DATE MAILED: 10/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/629,846	Applicant(s) MCDONNELL ET AL.	
	Examiner Ariel Balaoing	Art Unit 2683	

**– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 17 August 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-5, 7-21 and 23-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-21 and 23-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. This Action is in response to Applicant's amendment filed on August 17, 2005.

Claims 1-5, 7-21, 23-31 are pending

### ***Response to Arguments***

2. Applicant's arguments filed August 17, 2005 have been fully considered but they are not persuasive.

3. Regarding amended claims 1, 17, 18, and 31, in response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, as stated by the applicant on page 9, paragraph 6 of the response, "JOKINEN discloses the issuance of electronic coupons in response to a *mobile device getting into the vicinity of a particular location*," and GUNNARSSON "relates to a *wireless mobile terminal being alerted to its presence in an available wireless local area network* by a communication network". Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify GUNNARSSON to include the electronic coupons issuance of JOKINEN, as both systems relate to presence notification within a wireless communication network.

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4. Furthermore, in response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). As JOKINEN is concerned with advertising discounted services or goods at retail shops (see paragraphs 17-19, 50), the combination is proper.

Regarding claims 9 and 25, applicant further argues that KAMINKOW is not a proper reference against the present application. While the instant application does indeed claim a priority date of July 31, 2002, KAMINKOW is a continuation-in-part of application 09/927,742, which has a priority filing date of August 10, 2001. The subject matter from which the rejections of 9 and 25 rely upon (paragraph 64) is incorporated into the specification of application 09/927,742 and therefore claims priority of August 10, 2001.

5. Applicant's arguments with respect to claims 2-5, 7, 8, 11-16, 19-21, 26-31 have been considered but are moot in view of the new ground(s) of rejection.

***Claim Rejections - 35 USC § 103***

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. Claims 1, 2, 7, 8, 10-19, 23, 24, 27-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over GUNNARSSON et al (US 2003/0118015) in view of JOKINEN et al (US 2002/0095333 A1).

Regarding claim 1, GUNNARSSON discloses a communication system comprising a notifier being arranged to locate a mobile unit and to transmit a notification to said mobile unit (60-Figure 1-3) via a first telecommunication network (10-Figure 1-3) when said mobile unit moves within the vicinity of an access node of a second network [WLAN] (20-Figure 1-3) (abstract; paragraph 5, 18). However, GUNNARSSON does not disclose wherein the notification includes an electronic token. JOKINEN discloses wherein the notification includes an electronic token [e-coupon] (paragraphs 38, 55, 57). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify GUNNARSSON to include the electronic coupons issuance of JOKINEN, as both systems relate to presence notification within a wireless communication network. This is beneficial in that it allows the system of GUNNARSSON the ability to advertise discounted services or goods at a retail outlet.

Regarding claim 2, see the rejections of the parent claim concerning the subject matter this claim is dependant upon. GUNNARSSON further discloses wherein said notification comprises a voice message or text message (paragraph 22).

Regarding claims 7 and 23, see the rejections of the parent claims concerning the subject matter these claims are dependant upon. However, GUNNARSSON does not disclose wherein said electronic token has a redeemable monetary value. JOKINEN discloses wherein said electronic token has a redeemable monetary value

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(paragraph 38, 55, 57; the coupon is redeemable for a discounted amount on goods and services).

Regarding claims 8 and 24, see the rejections of the parent claims concerning the subject matter these claims are dependant upon. Although GUNNARSSON discloses that the access point can be placed at retail outlets (paragraph 15), GUNNARSSON does not disclose wherein said access node is located at a retail outlet at which said electronic token is redeemable. JOKINEN discloses wherein said access node is located at a retail outlet at which said electronic token is redeemable (paragraph 57).

Regarding claim 10, see the rejection of the parent claim concerning the subject matter this claim is dependant upon. However, GUNNARSSON does not disclose wherein said electronic token is transmitted only when said mobile unit is in communication with said second network. JOKINEN discloses wherein said electronic token is transmitted only when said mobile unit is in communication with said second network (paragraph 38).

Regarding claim 11, see the rejections of the parent claim concerning the subject matter this claim is dependant upon. GUNNARSSON further discloses wherein said mobile unit is capable of communicating with both said first and said second networks, said mobile unit being capable of communicating with said second network only when said mobile unit is within a predetermined range of said access node (paragraph 24, 28).

Regarding claim 12, see the rejections of the parent claim concerning the subject matter this claim is dependant upon. GUNNARSSON further discloses further comprising a further mobile unit [wireless computing device] (70-Figure 2, 3) for communication with said second network, said further mobile unit being capable of communication with said second network only when said mobile unit is within a predetermined range of said access node (paragraph 18, 28).

Regarding claim 13, see the rejections of the parent claim concerning the subject matter this claim is dependant upon. GUNNARSSON further discloses wherein the rate of communication with said second network is at a higher data rate than the rate of communication with said first network (paragraphs 14, 17; WLAN is preferred for high-bandwidth data transfers. It is also known the art that local area networks in general have higher data transfer rates then mobile communication networks).

Regarding claim 14, see the rejections of the parent claim concerning the subject matter this claim is dependant upon. GUNNARSSON further discloses wherein the location of the access node is held on a storage medium [database] in communication with said first network (paragraph 22).

Regarding claim 15, see the rejections of the parent claim concerning the subject matter this claim is dependant upon. GUNNARSSON further discloses wherein said first network comprises a cellular communication system (abstract; paragraph 12, 20).

Regarding claim 16, see the rejections of the parent claim concerning the subject matter this claim is dependant upon. GUNNARSSON further discloses wherein said

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second network comprises a wireless LAN or a 3G pico-cell (abstract; paragraph 14, 16).

Regarding claim 17, GUNNARSSON discloses a telecommunication system comprising: at least one base station (14-Figure 1) for communication with at least one mobile communication device via a first wireless telecommunication network (paragraph 12); means for determining the location of the mobile communication unit (paragraph 18); means for accessing a data storage device having the location of at least one access point of a second wireless telecommunication network stored thereon (paragraph 22); and means for causing a notification to be transmitted to the mobile communication device when the mobile communication device first comes within a predetermined distance of the access point of the second wireless telecommunication network (paragraphs 18, 22, 28). However GUNNARSSON does not disclose wherein the notification comprising an electronic token redeemable at the location of the access point. JOKINEN discloses wherein the notification comprising an electronic token redeemable [e-coupon] (paragraphs 38, 55, 57) at the location of the access point. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify GUNNARSSON to include the electronic coupons issuance of JOKINEN, as both systems relate to presence notification within a wireless communication network. This is beneficial in that it allows the system of GUNNARSSON the ability to advertise discounted services or goods at a retail outlet.

Regarding claim 18, GUNNARSSON further discloses a method of notifying a mobile device user to the presence of a network access node (abstract), the mobile



device being in communication with a first network (10-Figure 1-3), the method comprising: determining the location of said mobile device (paragraph 18); and transmitting a notification from said first network to said mobile device when said mobile device moves within the vicinity of a network access node of a second network (paragraph 18, 28). However, GUNNARSSON does not disclose wherein the notification includes an electronic token. JOKINEN discloses wherein the notification includes an electronic token [e-coupon] (paragraphs 38, 55, 57). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify GUNNARSSON to include the electronic coupons issuance of JOKINEN, as both systems relate to presence notification within a wireless communication network. This is beneficial in that it allows the system of GUNNARSSON the ability to advertise discounted services or goods at a retail outlet.

Regarding claim 19, see the rejections of the parent claim concerning the subject matter this claim is dependant upon. GUNNARSSON further discloses wherein said notification includes a voice message or text message (paragraph 22).

Regarding claim 27, see the rejections of the parent claim concerning the subject matter this claim is dependant upon. GUNNARSSON further discloses wherein the location of said at least one network external access node is held in a storage medium, said storage medium being in communication with said first network (paragraph 22).

Regarding claim 28, see the rejections of the parent claim concerning the subject matter this claim is dependant upon. GUNNARSSON further discloses wherein communication with said second network is achieved using said mobile device when

said mobile device is within a predetermined range of said external access node (paragraph 24).

Regarding claim 29, see the rejections of the parent claim concerning the subject matter this claim is dependant upon. GUNNARSSON further discloses wherein communication with said second network is achieved using a further mobile device when said further mobile device is within a predetermined range of said external access node (paragraph 18, 28).

Regarding claim 30, see the rejections of the parent claim concerning the subject matter this claim is dependant upon. GUNNARSSON further discloses wherein communication with said second network occurs at a greater data rate than communication with said first network (paragraphs 14, 17; WLAN is preferred for high-bandwidth data transfers. It is also known the art that local area networks in general have higher data transfer rates then mobile communication networks).

Regarding claim 31, GUNNARSSON discloses A method of notifying a mobile communication device user to the presence of a network access point (abstract, paragraph 18), the method comprising transmitting a notification to a mobile communication device via a first telecommunication network when that mobile communication device first moves within a predetermined distance of a network access point (paragraphs 18, 22, 28), a wireless communication system having one or more access nodes to the wireless communication system, the method further comprising providing details of the location of said one or more access nodes to a further telecommunication network (abstract, paragraphs 22, 23, 28). However

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GUNNARSSON does not disclose wherein the notification comprises a reward redeemable at a retail outlet located at the network point. JOKINEN discloses wherein the notification comprises a reward redeemable at a retail outlet located at the network point (paragraphs 38, 55, 57). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify GUNNARSSON to include the electronic coupons issuance of JOKINEN, as both systems relate to presence notification within a wireless communication network. This is beneficial in that it allows the system of GUNNARSSON the ability to advertise discounted services or goods at a retail outlet.

8. Claims 3-5, 20, 21 rejected under 35 U.S.C. 103(a) as being unpatentable over GUNNARSSON et al (US 2003/0118015) in view of JOKINEN et al (US 2002/0095333 A1) and further in view of JUURIKKO (US 2003/0003868 A1).

Regarding claims 3 and 20, see the rejections of the parent claims concerning the subject matter these claims are dependant upon. However, the combination of GUNNARSSON and JOKINEN does not disclose wherein said notification includes the location of said access node. JUURIKKO discloses wherein said notification includes the location of said access node (paragraph 23). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the paging of the combination of GUNNARSSON and JOKINEN to include locations and directions to the wireless access points, as taught by JUURIKKO as both disclosures deal with sending notification to a mobile device in regards to locating an access point. This is beneficial in that it allows the combination of GUNNARSSON and JOKINEN the

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ability to quickly move towards the access point to achieve greater signal strength and network reliability with the WLAN.

Regarding claim 4, see the rejections of the parent claims concerning the subject matter these claims are dependant upon. GUNNARSSON further discloses wherein the notification further comprises one or more from the list including the data transfer rate supported by the access node, details of the transmission coverage provided by the access node, the cost to a user of utilizing the access node and details of goods and services available at the access node (paragraph 22).

Regarding claims 5 and 21, see the rejections of the parent claims concerning the subject matter these claims are dependant upon. However, the combination of GUNNARSSON and JOKINEN does not disclose wherein said notification includes directions to said access node. JUURIKKO discloses wherein said notification contains directions to said access node (paragraph 23). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the paging of the combination of GUNNARSSON and JOKINEN to include locations and directions to the wireless access points, as taught by JUURIKKO as both disclosures deal with sending notification to a mobile device in regards to locating an access point. This is beneficial in that it allows the combination of GUNNARSSON and JOKINEN the ability to quickly move towards the access point to achieve greater signal strength and network reliability with the WLAN.

9. Claims 9 and 25 rejected under 35 U.S.C. 103(a) as being unpatentable over GUNNARSSON et al (US 2003/0118015) in view of JOKINEN et al (US 2002/0095333

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A1) as applied to the parent claims above, and further in view of KAMINKOW et al (US 2003/0036425 A1).

Regarding claims 9 and 25, see the rejections of the parent claims concerning the subject matter these claims are dependant upon. However, the combination of GUNNARSSON and JOKINEN does not disclose wherein said electronic token comprises a gaming credit. KAMINKOW discloses wherein said electronic token comprises a gaming credit (paragraph 64). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the combination of GUNNARSSON and JOKINEN to include the transmission of gaming credits during the notification of a WLAN as the systems disclose a method for transmitting coupons for location dependant services. This is beneficial in that it allows the combination of GUNNARSSON and JOKINEN the ability to lure customers to a gaming establishment using the notification of a WLAN in the vicinity.

10. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over GUNNARSSON et al (US 2003/0118015) in view of JOKINEN et al (US 2002/0095333 A1) as applied to claim 22 above, and further in view of VAISANEN et al (US 6,560,443 B1).

Regarding claim 26, see the rejection of the parent claim concerning the subject matter this claim is dependant upon. However, GUNNARSSON does not disclose wherein said electronic token is transmitted to said mobile device when said mobile device is in communication with said second network. JOKINEN discloses wherein said electronic token is transmitted to said mobile device when said mobile device is in

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communication with said second network (paragraph 38). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify GUNNARSSON to include the electronic coupons issuance of JOKINEN, as both systems relate to presence notification within a wireless communication network. This is beneficial in that it allows the system of GUNNARSSON the ability to advertise discounted services or goods at a retail outlet. However, the combination of GUNNARSSON and JOKINEN does not disclose wherein transmission occurs when the mobile is in communication with the second network and is not in communication with the first network. VAISANEN discloses wherein transmission occurs when the mobile is in communication with the second network and is not in communication with the first network (Figure 1; abstract; column 6:line 36-column 7:line 22). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the combination of GUNNARSSON and JOKINEN to communicate to a second network only when not in communication with a first network, as this enhance performance of the system.

***Claim Rejections - 35 USC § 112***

11. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 26 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which

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was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Amended claim 26 recites the limitation "when said mobile device is in communication with said second network and is not in communication with said first network". In the specification (see pages 3 and 8), an alternative embodiment of the invention relies on separate mobile units to communicate with the first and second networks, however, the mobile device as a whole (comprising both mobile units) still communicates with both networks simultaneously.

### ***Conclusion***

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ariel Balaoing whose telephone number is (571) 272-7317. The examiner can normally be reached on Monday-Friday from 8:00 AM to 4:30 AM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Trost can be reached on (571) 272-7872. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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